

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : James A. Parker Art Unit: : 2144
Serial No. : 09/915,719 Examiner: : Maniwang, Joseph R.
Filing Date : July 25, 2001
Title : Electronic Mail File Access System

Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

PETITION

Dear Sir:

Type and Grounds of Petition: Assignee respectfully files this petition under 37 CFR §§1.127, 1.181 invoking the supervisory authority of the Director to overturn an *ex parte* action of the Examiner that is not subject to appeal and not otherwise provided for, including specifically refusal to enter an amendment.

Relief Requested: Assignee respectfully requests that the actions in the Advisory Action dated June 6, 2007 (signed by William Vaughn, SPE) be reversed and a proper Advisory Action issued promptly. The specific actions taken in that paper that assignee challenges and seeks to have reversed are the actions in (1) refusing to enter assignee's *amendment* after final rejection dated May 10, 2007, and (2) refusing to "enter into the record" or consider assignee's *arguments* in its response to final rejection.

Deciding Official: Pursuant to MPEP 1002.02(c)(3)(g), assignee believes that the Director has delegated authority to decide petitions of this sort to the Technology Center Directors.

Fees: No fee is thought due on account of this petition.

Facts: The following facts appear pertinent to this petition:

1. The Examiner issued a final Office Action dated January 30, 2007.
2. The final Office Action allowed a number of claims, identified certain dependent claims as allowable if written in independent form, and rejected the rest of the claims.
3. Without getting into excessive detail, the Office Action held that the *allowed* claims were distinct from the primary cited prior art reference because the reference “did not disclose a first, second, and third field” for the purposes claimed.
4. The undersigned held a telephone interview with the examiner on February 7, 2007, for which the examiner issued an interview summary dated February 26, 2007.
5. As recorded in the interview summary, the “Examiner invited Applicant to contact the Office at a later date with proposed claim amendments and comment if further discussion was desired.”
6. Specifically, the examiner invited assignee’s undersigned representative to submit a proposed *draft* response with amendments and remarks explaining the points discussed in the interview.
7. Assignee sent a draft response by facsimile on or about March 27, 2007, and left messages indicating that “further discussion was desired.”
8. The undersigned had a further telephone interview with the examiner and SPE Vaughn on May 10, 2007, about the draft response.
9. After the interview, but on the same day, May 10th, the undersigned revised the draft response in line with suggestions made by the examiner in the interview and filed it with the Office as a Response to final Office Action.
10. No amendments were presented in the Response amending *allowed* claims 1-14 and 44-48.
11. With regard to a first group of rejected claims, assignee presented arguments, in the interview and in the Response, to the effect that independent claims 15, 16, 22, and 25 were allowable for the same reasons as those given for allowing claims 1-14, namely that there were three distinct fields specified.

12. In the interview, the examiner suggested that assignee might propose an amendment to claim 15 (written in “means/function” format) specifically identifying the “means” in question as the three fields, parallel to the point being argued. Assignee complied in the Response.

13. In the interview, the examiner suggested that assignee might propose an amendment to claims 16 and 22 clarifying that, despite the word “further” already in those claims, the two fields mentioned in the body of those two independent claims were separate from the first field mentioned in the preamble. Assignee complied in the Response.

14. In the interview, the examiner suggested that assignee might propose an amendment to claim 25 clarifying that the “indicia” in part (c) were not in the first field mentioned in part (b). Assignee complied in the Response.

15. In the interview, assignee’s representative sought assurance that the amendments suggested by the examiner (which the undersigned viewed as merely confirming limitations already apparent from the claims’ wording anyway) would be entered under Rule 116. The examiner gave such an assurance.

16. With regard to a second group of claims, assignee argued in the interview and the Response that independent claims 29 and 49 contained a limitation lacking from either of the combined references and that the Office had previously apparently failed to notice the distinction.

17. The examiner and SPE had no rebuttal to assignee’s argument in the two interviews but rather agreed that assignee’s argument would require reconsideration (and presumably allowance of those claims).

18. In the Response, assignee did not amend those claims at all, but rather simply presented argument in writing.

19. With regard to another independent claim, namely claim 26, assignee presented, in the interview and the Response, certain arguments against the several rejections in the final Office Action but did not amend the claim at all.

20. With regard to the final independent claim, namely claim 53, assignee presented arguments parallel to those applicable to claim 26.

21. In the Response, assignee sought to insert the term “tangible” to support the arguments presented concerning this claim that the medium was not intangible as the final Office Action had asserted.

22. In addition, the final Office Action rejected claim 53 for indefiniteness under 35 USC §112(2) for use of the term “properly programmed.”

23. In the Response, assignee sought to overcome the 112(2) rejection by deleting the term, “properly programmed,” which the examiner and assignee had agreed was unnecessary.

24. The Advisory Action: By paper dated June 6th, the Office (per SPE Vaughn) stated that “the proposed amendment will not be entered.”

25. The Advisory Action further stated, “The request for reconsideration has been considered but does NOT place the application in condition for allowance because: The argument relied upon by Applicant has not been entered into the record.”

26. Assignee’s representative sought reconsideration by telephoning the examiner of record on June 12.

27. Interview report (June 12): The examiner said that the changes in the claims did not look particularly extensive. He offered to work through the claims and issues and assist in putting them into condition for allowance or appeal; an offer that the undersigned enthusiastically accepted. The undersigned emphasized the need to conclude that task well before today’s five-month extension deadline, and the examiner agreed but said that he needed to consult with his SPE, Mr. Vaughn, first and hence would call the undersigned back by the end of the week.

28. The examiner never called the undersigned back and has not returned any of five separate phone messages from the undersigned in the past two weeks.

The facts stated above are either apparent from the record or presented here as further interview reports. Thus, no evidence or declarations is required to support the above facts.

Argument

A. **Claims not amended.** With respect to independent claims 26, 29, and 49, assignee presented no amendments – only arguments – in the Response to final.

The Advisory Action stated, “The argument relied upon by Applicant has not been entered into the record.” Further, the Advisory Action was signed by the SPE and not the examiner.

It is thus apparent that the examiner has not considered assignee’s arguments.

According to MPEP 706.07(f)(III): “Replies after final should be processed and considered promptly by all Office personnel.” [Emphasis added]

Assignee is entitled to consideration by the examiner, and entry into the record, of the Response to final.

According to MPEP 707.07(f): “Where the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant’s argument and answer the substance of it.”

The arguments presented with respect to claims 29 and 49 have been presented in assignee’s response to office action filed November 2, 2005, pp. 19-20, and in the Response to final filed May 10, 2007, pp. 17-18. The distinction argued with respect to that group of claims (the “second group” identified above) has been pointed out to the examiner and SPE during the interviews. The examiners have had no response to the point, yet no office action so admits or “answers the substance of” assignee’s argument.

With regard to claim 26, assignee responded to and traversed the examiner’s arguments in the final office action in the Response filed May 10th, pp. 18-20. The advisory action does not “answer the substance of” the arguments.

A proper advisory action should be issued entering into the record the arguments presented, and consideration should be shown through a proper action either accepting the arguments, in whole or in part, or taking note of the arguments presented and answering the substance of those arguments.

The same remedy should be applied to the arguments presented in the Response with respect to claims for which the Response proposed amendments, regardless of whether those amendments are admitted for entry or not based on the arguments in

parts B-G below. Those arguments include (1) the argument on pages 14-17 of the Response with regard to the “first group” of claims, and (2) the arguments on pages 18-22 of the Response with respect to claim 53.

B. Amendment to delete “properly programmed” in claim 53. An amendment was presented to claim 53 to delete the term “properly programmed” to overcome a rejection for indefiniteness (35 USC §112(2)). The advisory action refused to enter that amendment.

According to 37 CFR §1.116(b)(2), “An amendment presenting rejected claims in better form for consideration on appeal may be admitted.” Also, according to paragraph (1) of Rule 116(b), “An amendment may be made ... complying with any requirement of form expressly set forth in a previous Office action.”

Plainly, in an appeal of this application, rejected claim 53 would be in better condition without the unnecessary language that drew the indefiniteness rejection. Removal of that language would not cause any need for a new search or any alteration of the other rejections of that claim (which are made under §101, 103). Indeed, the same rejections have been entered for claims 26 and 53, with the exception of the indefiniteness rejection of the latter, which proves the point.

The amendment to claim 53 should have been entered to remove one of the three rejections of this claim, and this petition requests that such be done.

C. Amendment to insert the word “tangible” in claim 53. Another amendment was presented to claim 53 to insert the word “tangible.” The advisory action refused to enter that amendment as well.

The amendment in question responds in part to the rejection in the final Office Action under 35 USC §101. One of the Office’s arguments was that the first element of the claimed combination, “a transmission medium forming at least part of a computer network” might be intangible. Office Action, p. 3 (“The claimed ‘transmission medium’ can be reasonably interpreted by one of ordinary skill in the art as intangible transmission mediums common within the art (e.g., electromagnetic signals, carrier waves)”). Assignee argued to the contrary but also sought to insert the word “tangible,” to make the argument untenable expressly.

The amendment to insert the word “tangible” would not impact the other rejections or require any new search. Clearly, the §103 rejection, if warranted, would apply equally whether the word “tangible” was included or not.

However, insertion of the word “tangible” would place the claim in better “in better form for consideration on appeal.” 37 CFR §1.116(b)(2). It should be admitted.

D. Amendments to claims 16, 22, and 50 (part (a)). Each of these claims was amended in a like fashion, in a way requested by the examiner during the interview. Each of the claims first refers to a “message recipient field.” Then, each of the claims refers to the method “further includ[ing] a file viewer field and a file editor field.” The examiner, in the interview, requested clarity that the two latter fields were separate from the first field. The word “further” seemed to make that clear anyway, but assignee had no difficulty in changing “further” to “further to the message recipient field” to make it even more clear.

The amendment would not require a new search and its entry would place the claim in better “in better form for consideration on appeal.” 37 CFR §1.116(b)(2). It should be admitted.

E. Amendment to claim 25. This claim was amended for similar reasons to those in part D just above. The claim (part (a)) refers to a computer program that displays “a message window including a message recipient field.” Then, the claim (part (c)) specifies that the program “includes, in the electronic message, indicia designating addresses entered into the message recipient field as ...” having certain characteristics. Because the claim refers to the “indicia” in addition to the contents of the “message recipient field,” it was clear that the indicia is not simply the same as the contents of that field. However, to clarify the point, again at the suggestion of the examiner, assignee proposed an amendment to clarify that the indicia were in a “field ... separate from the message recipient field.”

The amendment would not require a new search and its entry would place the claim in better “in better form for consideration on appeal.” 37 CFR §1.116(b)(2). It should be admitted.

F. Amendment to claim 50, part (b). This amendment was to change “addresses inputted into” to “addresses identified in” at two locations in this dependent claim. This change is merely a matter of form. Because the claim is to a stored computer program, the proper format would not look to the act of the user inputting addresses but rather the addresses identified in the field (previously inputted).

The amendment would not require a new search and its entry would place this dependent claim in better “in better form for consideration on appeal.” 37 CFR §1.116(b)(2). It should be admitted.

G. Amendments to claim 15. The amendment related to this “means plus function” claim, *see* 35 USC §112(6). Assignee had argued that the claim’s “means” language could not be properly interpreted as “all means” for performing the stated functions, per MPEP 2106 at pp. 2100-7 to -8; *In re Donaldson*, 16 F.3d 1189, 1193, 29 USPQ2d 1845, 1848 (Fed. Cir. 1994) (en banc); *In re Alappat*, 33 F.3d 1526, 1540, 31 USPQ2d 1545, 1554 (Fed. Cir. 1994) (en banc). In the interview, the examiner suggested that the portions of the specification that assignee argued could be stated expressly in the language of the claim, to clarify the portions of the specification being referenced. Assignee did so, and the amendment incorporates the same “three field” system that the Office Action already searched and deemed allowable into this claim.

The amendment would not require a new search and its entry would place this claim in better “in better form for consideration on appeal.” 37 CFR §1.116(b)(2). It should be admitted.

Conclusion: The Office’s rules require that the examiner consider amendments after final, particularly when they are submitted after an interview in line with the examiner’s requests. Reflexive issuance of advisory actions stating that “a new search is required” causes further work and expense for applicants and is improper. The advisory action is particularly improper in this case because it refuses to enter into the record even assignee’s arguments.

Assignee and the undersigned thank the Office for its consideration of this petition and respectfully requests prompt grant of the requested relief.

If any further questions or issues arise, the undersigned invites any appropriate Office official to call.

TACIT NETWORKS, INC.

by its attorney

Dated: July 2, 2007

/Louis J. Hoffman/

Louis J. Hoffman

Reg. No. 38,918

LOUIS J. HOFFMAN, P.C.

11811 North Tatum Boulevard

Suite 2100

Phoenix, Arizona 85028

(480) 948-3295